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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,635

Applicant(s)

GARRICK ET AL.

Examiner

Patrice Winder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 18-29, drawn to is a method of defining the objectives of web page, defining success for each objective, testing the web page and identifying the success ratio for each objective, classified in class 715, subclass 513.
 - II. Claims 1-17, 30, drawn to a method of measuring the effectiveness of a test web page, classified in class 709, subclass 224.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because testing the web page focuses on the defined objectives the features without the particulars of invention II. The subcombination has separate utility such as a method of counting the number of visits to a web page as a measure of effectiveness without the features of invention I.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Newly submitted claims 18-29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Reissue Applications

6. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

7. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

Specific changes or amendments to the claims must be identified. If new claims are presented, their differences from the original claims must be pointed out. See MPEP 1414.

8. Claims 1-17, 30 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

9. The amendment to the claims filed on October 19, 2001 does not comply with the requirements of 37 CFR 1.121(h) because the amendment is in improper form. Amendments to the claims in reissue applications must comply with 37 CFR 1.121(h) which states:

- (h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

Specifically, § 1.173(b)(2), which states:

- (2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

Appropriate correction is required. Please note, in addition, the amendment specifically does not meet the requirements of 1.173 (c) which requires an explanation of the support in the disclosure for the new claims.

10. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-10, 12-15, 17 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson, USPN 5,918,014 (hereafter referred to as Robinson).

13. Regarding claim 1, Robinson taught a process for measuring effectiveness of a web site having a test web page (column 4, lines 58-61),
the process comprising:
designing one or more versions of the test web page (column 4, lines 8-13, 39-42);

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distributing requests to the various versions of the test web page according to a predetermined distribution function (column 4, lines 25-30, 44-53); and counting visits to one or more hyperlinks from each version of the test page to determine a relative effectiveness of each version of the test web page (column 3, line 67 – column 4, line 6, column 4, lines 58-61).

14. Regarding dependent claim 2, Robinson taught said predetermined distribution function is a sequential function (column 3, lines 3-7, column 4, lines 51-53).

15. Regarding dependent claim 3, Robinson taught said predetermined distribution function is a random function (column 3, lines 3-7, column 4, lines 51-53).

16. Regarding dependent claim 4, Robinson taught distributing requests comprises:
receiving requests for the test web page (user makes a request for hosting web site, column 4, lines 39-42);

directing said request to one of the versions of the test web pages in accordance with the predetermined function (column 4, lines 44-53).

17. Regarding dependent claim 5, Robinson taught further comprising:
repeating the process (column 4, lines 1-6);
after a preset number of repetitions, evaluating a success of each version of the test page (column 16, lines 53-58); and

selecting a version having a highest success rate, and setting the test web page to the selected version (column 16, lines 59-67).

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18. Regarding claim 6, Robinson taught a process for directing requests for a test web page having predetermined universal resource location (URL) (column 4, lines 39-46) comprising:

designing one or more version of the test web pages (column 4, lines 8-13, 39-42);
distributing requests to a version of the test web page according to a predetermined distribution function wherein said requests are distributed by directing requests for said test page to one or more versions of the test page in accordance with a predetermined distribution function (column 4, lines 25-30, 44-53); and
measuring a relative effectiveness of each version of the test web site, based on this success percentage (column 3, line 67 – column 4, line 6, column 4, lines 58-61).

19. Regarding dependent claim 7, Robinson taught said predetermined distribution function is a random function (column 3, lines 3-7, column 4, lines 51-53).

20. Regarding dependent claim 8, Robinson taught said predetermined distribution function is a sequential function (column 3, lines 3-7, column 4, lines 51-53).

21. Regarding claim 9, Robinson taught a method of measuring the effectiveness of a web page having different versions, the method comprising:

displaying a version of the web page to a user (column 4, lines 44-47), the version selected according to a predetermined function (column 4, lines 25-30, 47-53);

for each version of the web page, counting occurrences of desired behavior of the user to track the effectiveness of that version of the web site (column 3, line 67 – column 4, line 6, column 4, lines 58-61).

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22. Regarding dependent claim 10, Robinson taught further comprising upon completion of testing:

identifying an effective version of the web page based on the percentage of success of achieving the desired behavior (column 4, lines 1-6); and

setting the web page to a most effective version of the web page (column 16, lines 53-67).

23. Regarding dependent claim 12, Robinson taught versions of the web page may differ in one or more of the following: layout, images, content, links, hypertext elements, complexity (column 4, lines 8-13).

24. Regarding dependent claim 13, Robinson taught each version of the web page only varies in one feature, such that each feature of the web page is independently tested for effectiveness (column 4, lines 8-13, 44-50).

25. Regarding dependent claim 14, Robinson taught the most effective version of the web page includes each feature having a highest rate of occurrences of the desired behavior (column 4, lines 1-6, column 9, lines 24-35).

26. Regarding dependent claim 15, Robinson taught the versions of the web page may be generated on-the-fly, when a request for the web page is received (column 4, lines 39-42).

27. Regarding dependent claim 17, Robinson taught the successful response comprises one or more of the following: reading the web page, following a link, purchasing an item, filling-in a form, interacting with the web page, downloading data from the web page (column 9, lines 24-35).

28. Regarding claim 30, Robinson taught a computer data signal embodied in a carrier wave (column 1, lines 16-24) comprising:

a web page display code segment to display a version of the web page to a user (column 4, lines 44-47), the version selected according to a predetermined distribution function (column 4, lines 25-30, 47-53);

an evaluation code segment to count the occurrence of a desired behavior of the user to track the effectiveness of each version of the web page (column 3, line 67 – column 4, line 6, column 4, lines 58-61).

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

31. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Jakob Nielsen et al., Improving System Usability Through Parallel Design (hereafter referred to as Nielsen).

32. Regarding dependent claim 11, Robinson does not specifically teach the most effective version of the web page is not identical to any of the versions tested. However, Nielsen taught the most effective version of the web page is not identical to any of the versions tested, the most effective version of the web page includes features from more than one version of the web page (Parallel design, page 29). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Nielsen's merged versions of user interfaces in Robinson's system for measuring web page effectiveness would have improved system utility. The motivation would have been to have a version that is the best of the test web page.

33. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Wexler, USPN 5,960,409 (hereafter referred to as Wexler).

34. Regarding dependent claim 16, Robinson does not specifically teach the versions of the web page are static web pages, generated in advance, and further comprising: configuring the versions of the test page in effective parallel paths. However, Wexler taught the versions of the web page are static web pages (column 4, lines 47-51), generated in advance (column 3, lines 36-40), and further comprising: configuring the versions of the test page in effective parallel paths (column 5, line 45-column 6, line 10). It would have been obvious to one of ordinary skill in the art at the

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time the invention was made that incorporating Wexler's parallel paths in Robinson's system for measuring web page effectiveness would have improved system efficiency. The motivation would have been to yield a faster final design.

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Prior art as cited in the patent application:

Shaffer et al., USPN B1 4,777,596: taught a word processing system employing text substitution wherein the typist defines short forms, which when typed as normal text initiate text substitution of the short form by a long form;

Nilakantan et al., USPN 5,541,911: taught a system that comprises a remote network interface, connected to the remote network, including data forwarding resources which, according to forwarding rules, forward data packets originated by users of the remote network across the communication link to the central device in response to characteristics of the data packets;

Levergood et al., USPN 5,708,780: taught when the user selects a hyperlink that is directed to an access-controlled file, the server subjects the request to a secondary server which determines whether the client has authorization;

Bland et al., USPN 5,732,218: taught an information-service management system for a client-server information network gathers specific service-management data that are related to interactions between at least one client and at least one server;

Gerace, USPN 5,848,396: computer network method and apparatus provides targeting of appropriate audience based on psychographic or behavioral profiles of end users;

Luotonen, USPN 5,864,852: taught a proxy server caching mechanism that provides a file directory structure and a mapping mechanism within the file structure;

Leshem et al., USPN 5,870,559 : taught a mapping component scans a web site over a network connection and builds a site map which graphically depicts the URLs and links of the site; and

Ari Luotonen et al., World-Wide Web Proxies : taught a proxied http transaction – client makes a request to the proxy server using http, but specifying the full URL; the proxy server connects to the remote server and requests the resource relative to that server.

Newly cited prior art

Graber et al., USPN 5,812,769: taught a method and apparatus for redirecting a user to a new location on the World Wide Web using relative universal resource locators;

Marsh et al., USPN 5,848,397: taught a method and apparatus for scheduling the presentation of a continuously changing display of messages to computer users;

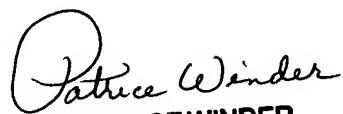
Merriman et al., USPN 5,948,061: taught a method of delivery, targeting, and measuring advertising over network, where statistics are compiled on individual users and network to permit targeting of advertisements to individual users;

Jakob Nielsen, A Home-Page Overhaul Using Other Web Sites: taught how to take advantage of competitors (others) good web design ideas.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-3938. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam, can be reached on (703) 308-6662. The fax phone number(s) for this Group is official (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


PATRICE WINDER
PRIMARY EXAMINER